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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,038	09/22/2003	Akinori Furuya	034620-105	1798

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EXAMINER
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BERNATZ, KEVIN M

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 03/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/669,038

Applicant(s)

FURUYA ET AL.

Examiner

Kevin M Bernatz

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 19-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Amendments to the specification and claims 19, 23, 24, 26 and 30, filed on December 9, 2004, have been entered in the above-identified application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claim 26 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for the reasons of record as set forth in Paragraph No. 6 of the Office Action mailed on September 9, 2004. The Examiner notes that claim 19 still refers to both a "recording layer" (*lines 1 – 2*) and a "garnet ferrite recording layer" (*line 3*), so the same clarity issue is present as noted in the prior office action.

### ***Claim Rejections - 35 USC § 102***

5. Claims 19 – 24 and 27 – 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Machida (U.S. Patent No. 4,883,710) for the reasons of record as set forth in Paragraph No. 8 of the Office Action mailed on September 9, 2004.

***Claim Rejections - 35 USC § 103***

6. Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Machida as applied above, and further in view of Licht (U.S. Patent No. 5,146,361) for the reasons of record as set forth in Paragraph No. 10 of the Office Action mailed on September 9, 2004.

***Response to Arguments***

7. The rejection of claims 19 - 30 under 35 U.S.C § 102(b) and/or 103(a) –  
**Machida, alone or in combination with Licht**

Applicant(s) argue(s) that the claimed processing conditions are different than the processing conditions utilized in the Machida invention, hence rendering the rejection under 35 U.S.C. 102(b) improper (*pages 8 - 10 of response*). The examiner respectfully disagrees.

As stated in the rejection of record, *process* limitations in a *product* claim are not germane to the determination of patentability of the *product* unless it can be shown that the processing steps result in an unobvious difference in the structure of the resulting product. While the Examiner acknowledges applicants' position that the specific process utilized in the prior art and in the claimed invention appear to be different, applicants have provided no *evidence* of any unobvious difference in the resulting product. Applicants are reminded that attorney arguments are not *evidence*.

Finally, applicants argue that Machida "does not teach or suggest a combination of garnet ferrite layer and an underlayer made from spinel ferrite, rutile-type oxide or hematite as claimed in claim 19" (*page 9 of response*). The Examiner respectfully disagrees.

As noted in the rejection of record, Machida teaches that first magnetic layer (*Figure 4, element 17*) can comprise a garnet ferrite layer ("*Examples of the magnetic oxide for the first magnetic layer are ... (3) iron-garnet ferrite*" – *col. 4, lines 34 – 41*) and that the second magnetic layer (*Figure 4, element 15*), which is formed under the first magnetic layer (and hence meets the structural limitations of the claimed "underlayer") can comprise a spinel ferrite layer ("*Examples of a magnetic oxide for the second magnetic layer are cobalt spinel ferrite and nickel spinel ferrite*" – *col. 4, lines 41 – 43*). Hence, Machida clearly teaches the recited structural elements.

### **Conclusion**

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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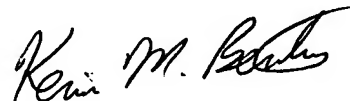
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin M Bernatz whose telephone number is (571) 272-1505. The examiner can normally be reached on M-F, 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KMB  
March 2, 2005

  
Kevin M. Bernatz, PhD  
Primary Examiner